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No. 95-728

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**In The Supreme Court  
OF THE  
United States**

**OCTOBER TERM 1995**

**WARNER-JENKINSON COMPANY, INC.,  
*Petitioner,***

**vs.**

**Hilton Davis Chemical Co.,  
*Respondent.***

**On Writ of Certiorari to the  
United States Court of Appeals  
for the Federal Circuit**

**BRIEF OF AMICUS CURIAE  
OHIO STATE BAR ASSOCIATION  
IN SUPPORT OF RESPONDENT**

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INTEREST OF THE AMICUS CURIAE

The Ohio State Bar Association is an unincorporated association of more than 25,000 members. Its membership includes lawyers, judges and associate members. It speaks on behalf of thousands of practitioners from a wide range of industrial, urban, and rural areas in a populous state, and on behalf of the six hundred members of its Intellectual Property Law Section, many of whom devote their careers largely to the procurement and enforcement of United States patents. The Association carefully guards the right to trial by jury in civil actions, and seeks to defend the use of this well-tested "common-sense" engine of justice against encroachments in the name of purported efficiency or certainty or predictability. This brief is authorized by the Board of Governors of the Association's Intellectual Prop-

erty Law Section and by the Board of Governors of the Association itself. Counsel for Petitioner and Respondent have consented to the filing of this brief.

The doctrine of equivalents is an important adjunct to enforcement of the patent laws and should not be abolished. Other amici (*e.g.*, the United States, the Intellectual Property Owners, the American Intellectual Property Law Association ["AIPLA"]) have stated well the rationale for the doctrine, and this Amicus will not add to those statements.

The doctrine of equivalents should not be applied depending on the conduct, motive or intent of the accused infringer. Other amici have adequately stated the reasons why this limitation upon use of the doctrine proposed by dissenters below should be rejected as contrary to the very concept of uniformity in enforcing patent claims otherwise sought by Petitioner. This Amicus will not further address that question.

This Amicus seeks to address only the Petitioner's challenge to the submission of the equivalence issue to a jury. The Federal Circuit determined, following many years of unbroken precedent, that the question whether an accused product infringes a patent under the doctrine of equivalents is a question of fact to be decided by a jury when a jury demand has been made. Two of the dissenting opinions suggested that the determination of infringement by equivalence should be removed from jury consideration and given to the trial court. Dissent by Plager, J., 62 F.3d at 1543; dissent by Lourie, J., 62 F.3d at 1549. Several amici support the dissenters on this point. This Amicus urges continuance of the present role of the jury in equivalents determinations.

## SUMMARY OF ARGUMENT

The doctrine of equivalents has long been applied by the courts of the United States through submission of the question of similar or equivalent structure to juries. This well-established practice has continued notwithstanding many revisions of the patent statutes, showing legislative recognition of and acquiescence in the doctrine. The principal cases of this Court clearly characterize equivalence analysis as a question of fact not of law, to be decided by a jury when demanded.

The *Markman* decision does not alter the accepted practice of submitting to the jury the question of equivalence after the court construes the words of the claims in its instructions to the jury. The doctrine of equivalents is not a separate construction of the patent that draws separate boundaries for the claims. Rather, the doctrine of equivalents assumes that the accused product or process falls outside the boundary drawn by the court in construing the claims, and merely asks the jury to determine whether the beyond-boundary difference in the accused product or process is so insubstantial as to make it equivalent in substance to the patented invention. This determination is not part of construing a written instrument, for which judges are particularly adept, but is a factual determination at which jurors are presumed to excel.

Neither the facts of this case nor the opinions in the court below or the briefs submitted to this Court demonstrate any pattern of substantial injustice or unconscionable results that would justify altering the long-standing doctrine of equivalents. However, certain comments made by dissenters below suggest a hostility to the use of juries in complex cases, a suggestion that should be rejected by this Court as inimical to the fundamental role of juries in all manner of civil actions in this country.



## ARGUMENT

### I. Determining Similarity of an Accused Device to the Patented Invention Has Long been a Factual Determination for the Jury.

Although *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605 (1950), is considered to be the definitive authority for the modern doctrine of equivalents, the concept of putting to the jury the question whether the accused product is so similar to the patented invention as to infringe the inventor's rights has been a part of American patent jurisprudence virtually from the beginning. This concept can first be found in a jury charge of Justice Bushrod Washington, sitting as a Circuit Justice in *Reutgen v. Kanowers*, 20 F. Cas. 555 (C.C.D. Pa. 1804), in which George Washington's nephew instructed the jury to determine whether the defendants were using "a machine similar to the one mentioned in the plaintiff's patent and specification." *Id.* at 556. Similarly, Justice Story, sitting as Circuit Justice in *Odiorne v. Winkley*, 18 F. Cas. 581 (C.C.D. Mass. 1814), charged the jury to consider "whether the machines used by the defendant are substantially, in their principles and mode of operation, like the plaintiff's machines." *Id.* at 582. He then defined the material question as "not whether the same elements of motion, or the same component parts are used, but whether the given effect is produced substantially by the same mode of operation, and the same combination of powers, in both machines." *Id.* Many other early cases requiring findings of similarity or equivalence are cited in Circuit Judge Newman's commentary in *Pennwalt Corporation v. Durand-Wayland, Inc.*, 833 F.2d 931, 957-70 (Fed. Cir. 1987).

The doctrine of equivalents first appeared in a Supreme Court decision in *Winans v. Denmead*, 56 U.S. (15 How.) 330, 342-43 (1853). At that time, the existing patent statute did not formally require distinct claims, but merely required that the patentee

particularly specify and point out the part, improvement, or combination, which he claims as his own invention or discovery.

Patent Act of 1836, 5 Stat. 117, 119, § 6. Thereafter in the Patent Act of 1870, 16 Stat. 198, 201, § 26, Congress amended the critical statutory language to require the patentee to

particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery.

While the 1870 statute is considered the genesis of the principle that the metes and bounds of an invention are set forth in the claims, *see, e.g., Pennwalt Corp. v. Durand-Wayland, Inc., supra*, 833 F.2d at 959, the previous statute under which the doctrine originated contained closely similar language requiring specificity in setting forth the claimed invention. In comparison, the present statute, 35 U.S.C. § 112, provides:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Nothing in the text of the present statute suggests that the role of the jury in determining whether the accused product is the same as, or insubstantially distinct from, the claimed invention should differ from the manner in which juries were used under the previous patent statutes.

More important than § 112 for defining the manner in which infringement is to be determined is the infringement statute, § 271, which provides that "whoever without authority makes, uses, offers to sell or sells any patented invention . . . during the term of the patent therefor, infringes the patent." This provision, last amended on January 1, 1996, does not say "whoever makes, uses or sells . . . a claimed invention" or "whoever practices any claim of

a patent.” Nothing in the statute requires that the factual determination of infringement occur exclusively within the explicit bounds of a claim,<sup>1</sup> even though § 271 has been amended repeatedly since the *Graver Tank* decision — most recently after the Federal Circuit announced its decision in this case. Congress accepts the manner in which infringement is determined under the doctrine of equivalents.

There is thus no reason within the patent statute for this Court to overrule the holding in *Graver Tank* that “[a] finding of equivalence is a determination of fact,” 339 U.S. at 609-610, upon which the court below grounded its decision, 62 F.3d. at 1520.

Amicus AIPLA asserts that the seminal *Winans* decision supports its view that the scope of equivalents is a question of law. To the contrary, *Winans* held precisely the opposite, namely, that the lower court erred in taking the question of infringement away from the jury because even though there could be no literal infringement of the claims, there was evidence to show that defendant’s octagonal railcars achieved substantially the same result as the plaintiff’s patented round railcars by substantially embodying his mode of operation. 56 U.S. (15 How.) at 343-44. The Court stated:

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<sup>1</sup>In *Graver Tank*, Petitioners raised the spectre of uncertainty, asserting that if the doctrine of equivalents were not repudiated, then “the claims of the patent no longer will serve to warn the public of the area closed to it,” citing *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938) and *Universal Oil Products Co. v. Globe Oil & Refining Co.*, 322 U.S. 471, 484-85 (1944), and asserting that businesses will face “fears and apprehensions of concealed liens and unknown liabilities,” citing *Atlantic Works v. Brady*, 107 U.S. 192, 200 (1883), and *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1, 12 (1946). Brief of Petitioners on Rehearing at 60. In deciding the *Graver Tank* case, this Court made an unequivocal determination that the need for business certainty is an insufficient reason to repudiate the doctrine of equivalents. The business-certainty argument has not changed since then, and the doctrine of stare decisis should dispose of it.

It may safely be assumed, that neither the patentee nor any other constructor has made, or will make, a car exactly circular. In practice, deviations from a true circle will always occur. How near to a circle, then must a car be, in order to infringe? May it be slightly elliptical, or otherwise depart from a true circle, and, if so, how far?

In our judgment, the only answer that can be given to these questions is, that it must be so near to a true circle as substantially to embody the patentee’s mode of operation, and thereby attain the same kind of result as was reached by his invention. It is not necessary that the defendant’s cars should employ the plaintiff’s invention to as good advantage as he employed it, or that the result should be precisely the same in degree. It must be the same in kind, and effected by the employment of his mode of operation in substance. *Whether, in point of fact, the defendant’s cars did copy the plaintiff’s invention, in the sense above explained, is a question for the jury, and the court below erred in not leaving that question to them upon the evidence in the case, which tended to prove the affirmative.*

56 U.S. (15 How.) at 343-44 (emphasis added). Amicus AIPLA seizes upon isolated passages referring to “the law” as somehow supporting its position that the “scope of equivalents” is a matter of law for the judge. To the contrary, in these passages, the Court was merely stating its conclusion, in opposition to that reached by the lower court, that non-literal infringement could be actionable: that it was recognized “in law.” This is made clear by putting these passages in context:

Where form and substance are inseparable, it is enough to look at the form only. Where they are separable; where the whole substance of the invention may be copied in a different form, it is



the duty of courts *and juries* to look through the form for the substance of the invention — for that which entitled the inventor to his patent, and which the patent was designed to secure; where that is found, there is an infringement; and it is not a defence, that it is embodied in a form not described, and in terms claimed by the patentee.

Patentees sometimes add to their claims an express declaration to the effect that the claim extends to the thing patented, however its form or proportions may be varied. But this is unnecessary. The law so interprets the claim without the addition of these words.

56 U.S. (15 How.) at 343 (emphasis added). Here again, the *Winans* Court reserved a role for the jury, not merely to apply the scope of equivalents as set forth by the court, but to look to the substance of the patent and make its own determination of whether the defendant had infringed it, despite the absence of literal infringement.

## II. The *Markman* Rule Does Not Alter the Manner In Which A Jury Determines Equivalence of An Accused Device to A Patented Invention.

This Court held in *Markman v. Westview Instruments, Inc.*, 116 S.Ct. 1384 (1996), that claim construction is purely a question of law to be decided by the court. Claims are construed by the court without reference to the accused product or process. The court instructs the jury on the proper construction of the claims. Then the jury determines whether the accused product or process falls within the scope of the claims as properly construed. This test of literal infringement is a factual determination.

Under the *Markman* rule, the same procedure must occur in cases asserting infringement by equivalents that is prescribed for cases of literal infringement. The court instructs the jury as to the proper construction of the claims. Then the jury determines whether, if the accused product or

process does not fall within the literal scope of the claims, the difference between the accused product or process is so insubstantial as to make it equivalent to the patented invention. This is a finding of fact.

Amicus AIPLA erroneously asserts that the doctrine of equivalents should encompass a two-step process in which the trial court first determines the scope of equivalents, and then the jury determines whether the accused product falls within that scope. Such proposed rule (which has no case-law support) contains a serious flaw — it assumes that the doctrine of equivalents operates to draw a boundary which is different than the boundary drawn by the language of the claims. Under such a rule, the judge would describe two boundaries for the jury: a boundary for literal infringement and a wider boundary for infringement by equivalents — a wholly anomalous result which can only confuse a jury.

The doctrine of equivalents does not involve construing the scope of a patent separate from the scope of the claims as literally construed. There is no second boundary to be drawn by the court. Rather, the doctrine of equivalents assumes that the accused product or process falls outside the boundary drawn by the court in its instructions to the jury. If so, then the jury may determine whether the beyond-boundary difference in the accused product or process is so insubstantial as to be equivalent to the claimed invention.

There is nothing inconsistent in assigning to the court the task of construing the claim and then allowing a jury in an appropriate case to determine equivalents. To do otherwise would improperly degrade the process of claim construction. Proper claim construction is performed without reference to the accused device or process. *SRI International v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1118 (Fed. Cir. 1985) (en banc). However, equivalence cannot be determined in a vacuum, without reference to an accused device. The question whether a device falling outside the scope of the claims has such an insubstantial difference as to be equivalent cannot begin to be addressed without consid-

ering the characteristics of the accused device and the scope of the claims as construed by the court. Thus the suggestion of the APLA that the court also construe the scope of equivalents, apparently without reference to the nature of the accused device, flies in the face of accepted patent law procedures.

The rationale of the *Markman* decision assigning claim construction exclusively to the court rested upon the premise that courts are more adept than juries at construing written legal instruments. This rationale is inapplicable to the determination whether a product or process is equivalent to the patented invention.<sup>2</sup> Juries are assigned by law and the Constitution the task of determining whether an accused device or process falls within the claim, and similarly they should function at least as well as judges in deciding whether, though not within the claim, the accused product or process is so close as to be equivalent. The latter determination is a question of fact, to be distinguished from construing a claim, as described by Circuit Judge Nies in dissent, 62 F.3d at 1578.

### III. Petitioner and Supporting Amici Fail to Demonstrate Any Public Policy Reason for Overturning the Right to Jury Determination of Infringement Under the Doctrine of Equivalents.

Neither the facts of this case, nor the briefs filed by Petitioner or the supporting amici, nor any of the opinions written by the judges of the court below, have presented any concrete instances in which submission of the question of infringement under the doctrine of equivalents to a jury has resulted in a fundamentally unjust verdict, or an anomalous

<sup>2</sup> If the applicability of the doctrine of equivalents to an accused product or process is circumscribed by prosecution history estoppel, then the court can make that determination using its expertise in construing written instruments, and can inform the jury of the limitations imposed by the contents of the prosecution history. This case does not squarely present a question of prosecution history estoppel to this Court.

result when compared to another case, or any example of the theoretical parade of horrors presented by those who would remove the determination of equivalents from a jury. All is speculation, theory, hypotheticals. The doctrine of equivalents is not a new development. Many years have passed in which, if all of the terrible results such as inconsistent application of patents to similar products, lack of certainty, and runaway juries were a natural consequence of allowing juries to consider infringement by equivalents, surely such results would have surfaced somewhere among the many cases decided under the patent laws. Before the longstanding and long-applied principle of *Winans* and *Graver Tank* is overruled, a petitioner should be required to demonstrate concretely that the present rule is producing results that are unjust, and that a change will produce more just results. Nothing in this record shows that switching the determination of infringement by equivalents from a jury to the trial judge will improve the quality of justice in patent cases.

The dissenting judges below do make reference to a very unfortunate public policy argument — an argument to which this Amicus takes emphatic exception. The suggestion that juries are too unsophisticated to decide complex issues should be rejected by this Court. In particular, Circuit Judge Lourie's expressed hostility to a jury considering "the greater complexity of today's patented high technology inventions," 62 F.3d at 1549 n. 3, and his statement that an equivalence determination should be reserved to the court because of the need to exercise "discretion," *id.* at 1549, is a flat condemnation of the ability of juries to decide hard cases and do justice. Juries routinely decide complex matters in many fields of law. They consider voluminous complex financial and economic evidence in securities fraud and antitrust cases, complex scientific forensic evidence in criminal cases, complex medical evidence in personal injury cases, and complex technological evidence in products liability cases. Complexity exceptions to the right to jury trial in a civil action, widely debated in the early 1980's, were never



adopted by this Court. R. Lempert, *Civil Juries and Complex Cases: Taking Stock after Twelve Years*, in VERDICT: ASSESSING THE CIVIL JURY SYSTEM (R. Litan ed. 1993). To a lesser extent, Circuit Judge Plager's peroration (62 F.3d at 1538) that the decision below is a "virtually uncontrolled and unreviewable license to juries to find infringement if they so choose" assumes that jurors cannot adequately decide when an accused product contains a significant change from the patented invention. He cites no past experience, no cases from many years of doctrine of equivalents jurisprudence, to support his assertion that jury determinations under the doctrine of equivalents are uncontrollable. The right to a jury determination of equivalents should not be overturned on such a thin showing as the record and arguments made in this case.

### CONCLUSION

For all of the above-stated reasons, the decision of the court below should be affirmed.

Respectfully submitted,

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